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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/960,627 | 09/21/2001 | Daniel R. Potter | 005127.00062 | 4285 |

22909 7590 04/30/2003

BANNER & WITCOFF, LTD.
1001 G STREET, N.W.
WASHINGTON, DC 20001-4597

| EXAMINER |
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STASHICK, ANTHONY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 04/30/2003

102

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,627

Applicant(s)

Potter et al.

Examiner

Anthony D. Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 16-31, 35 and 44-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 32-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6, 9.
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Figures 1-6 in Paper No. 11 is acknowledged. Although applicant noted that he believed that claims 26, 29 and 35 read on the elected species, the means for tightening connected to the sole portion and the midsole having a rim that flanks the foot portion are not shown in the elected figures. Therefore, these claims have been withdrawn as being directed to a non-elected species.

2. Claims 16-24, 26-28, 30-31 and 44-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No.

11. Also, applicant asserts that claims 1-2, 14-15, 25, 29 and 32-43 are generic claims. These claims are not believed to be generic claims as stated in the election/restriction requirement that there are no generic claims. A generic claim should include no material element additional to those recited in the species claims and **must** comprehend within its confines the organization covered in **each** of the species. Since claims 1-2, 14-15, 25, 29 and 32-43 do not comprehend within their confines the organization covered in each of the species, they do not appear to be generic claims.

Specification

3. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: in paragraph [13], line 5 the phrase "specifically the a tip the fifth metatarsal head on the lateral..." is unclear and should be corrected. Also, paragraph [59]. Line 2, reference number 122 was defined as "channels" then later in the same line, reference numbers 122a and 122b are referred to as "contacts". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 14-15, 32-34 and 36-43 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 91/10376 (WO '376). WO '376 discloses all the limitations of the claims including the following: resilient bladder 30, 22 for containing fluid; the

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bladder having a sole portion 30 adapted to be received by an opening 38 in the sole assembly; the bladder adapted to be positioned generally horizontally underneath a portion of the wearer's foot (30 placed within 38); a foot portion 22 extending generally vertically from the sole portion (see Figure 4); the foot portion adapted to be positioned to a side edge of a wearer's foot (see Figure 1); the sole and foot portion adapted to be positioned at a metatarsal region of a wearer's foot (see Figure 1); the sole and foot portion forming an L-shaped bladder (see Figure 4); the foot portion in fluid communication and integral with the sole portion (see Figure 4) wherein compression on the sole portion increases fluid pressure in the foot portion (only place for fluid to move to if compressed in foot portion); the sole portion of the bladder is thicker than the foot portion (see Figure 4); the sole portion is generally rectangular shaped (as seen in Figure 4); the foot portion is generally trapezoidal shaped (see Figure s 1 and 4, from side, 22 is trapezoidal in shape); the resilient bladder has a channel within it (that where fluid flows); the initial fluid pressure of the bladder is above ambient pressure (see page 5, lines 10-11, pressurizing the bladder with fluid, i.e. above ambient pressure); upper connected to sole assembly thereby defining a volume for receipt of user's foot (see Figure 1); foot portion

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of bladder positioned adjacent lateral or medial side edge of sole (see Figure 4); opening in sole 38; midsole having contour and sole portion having surface generally flush with midsole contour (see Figure 1 for midsole and outer sole); bladder has outer surface generally flush with the lateral or medial side of the midsole (see Figure 4 and 1, 34 fits 42 with 22 flush with outer surface of midsole); bladder has surface and article of footwear is adapted to visibly expose the surface to an exterior of the article of footwear (are which tongue covers); bladder has a surface portion that is at least translucent to allow for the interior to be visible from the exterior of the footwear (see page 2, line 25-page 3, line 8); the opening in the sole is adjacent the lateral or medial side edge (see Figure 4); the opening is positioned in the metatarsal region of the sole (see Figure 4); the foot portion of the bladder extends upwardly from the sole and has a top edge that tapers downward towards the front of the sole (See Figures 1 and 4); the sole portion of the bladder is thicker than the foot portion (see Figure 4).

7. Claims 1, 4, 5, 14-15, 32-34, 36 and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim 5,383,290. Grim '290 discloses all the limitations of the claims including the following: (see Figures 7 and 8) resilient bladder 82, 86, 87, 88, 89 for containing fluid; the bladder having a sole

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portion 82 adapted to be received by an opening (see Figure 7, opening is shown between insole and outsole) in the sole assembly; the bladder adapted to be positioned generally horizontally underneath a portion of the wearer's foot (see Figure 7); a foot portion 86, 87 extending generally vertically from the sole portion (see Figure 7); the foot portion adapted to be positioned to a side edge of a wearer's foot (see Figure 7); the sole and foot portion adapted to be positioned at a metatarsal region of a wearer's foot (see Figure 7); the sole and foot portion forming an L-shaped bladder (See Figure 7, also best shown in Figure 9); the foot portion in fluid communication and integral with the sole portion wherein compression on the sole portion increases fluid pressure in the foot portion (only place for fluid to move to if compressed in foot portion); the resilient bladder has a channel (that where fluid is located in the bladder); pressure in resilient bladder is above ambient (increased by pump); upper connected to sole assembly and defining volume for foot (see Figure 7); foot portion of bladder positioned adjacent the lateral or medial side edge (see Figure 7); foot bed of sole having medial and lateral side edges (where medial and lateral side edges of bladder sole portion 82 is placed within); foot portion of bladder extending upwardly at the lateral or medial side edge (see Figure 7); midsole having

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contour and sole portion has surface that is flush with the midsole contour (see Figure 7); midsole has a lateral and medial side and the bladder has an outer surface that is generally flush with the medial or lateral side (see Figure 7, but best shown in Figure 9); bladder has a surface and the article of footwear is adapted to visually expose the surface to an exterior of the article of footwear (through area where foot is placed within the shoe); the opening is adjacent the lateral or medial side edge (where tongue covers opening); the opening is positioned in a metatarsal region of the sole (see Figure 7 where tongue is located); the foot portion has a top edge that tapers downwardly toward the toe region (see center to front of 86 as placed in Figure 7).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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9. Claims 2, 4, 6-13 and 43 are rejected under 35

U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 40 above in view of Allen et al.

5,313,717. The references as applied to claims 1 and 40 above disclose all the limitations of the claims except the sole portion of the bladder being thicker than the foot portion; the bladder having a channel for improving the flexibility and structural integrity of the bladder, and the limitations with respect to the recess in the top surface and the contacts.

Allen et al. '717 teaches that a bladder used within a shoe sole can have a sole portion 34, 36 that is thicker than the foot portion 28 (made up of layer 36) to allow for better cushioning of the user's foot with the impact of the shoe to the ground.

Allen et al. '717 also teaches that channels can be recessed in the top surface of the bladder to control flow of the fluid (channels defined by clefts 52) with the channels running perpendicular to the foot section (see Figure 3). The sole having a bottom surface with a contact (clefts 52) that connects the bottom surface to the channels. These clefts being oval in shape (see Figure 3) with the channels extending to the inside surface of the foot portion. These clefts allow for the bladder to flex (see col. 6, lines 47-53). Therefore, it would have been obvious, to one of ordinary skill in the art at the time

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the invention was made, to place clefts defining channels, as taught by Allen et al. '717 in the bladder of the references as applied to claims 1 and 40 above to allow for better fluid control and flexibility of the bladder with respect to the natural flexion of the user's foot.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D. Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday-Thursday, 6:00 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

| | |
|---------------------------------|---------------------|
| Allowed Files & Publication | (703) 305-8322 |
| Assignment Branch | (703) 308-9287 |
| Certificates of Correction | (703) 305-8309 |
| Drawing Corrections/Draftsman | (703) 305-8404/8335 |
| Fee Increase Questions | (703) 305-5125 |
| Intellectual Property Questions | (703) 305-8217 |
| Petitions/Special Programs | (703) 305-9282 |
| Terminal Disclaimers | (703) 305-8408 |
| Informal Fax for 3728 | (703) 308-7769 |

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

| | |
|------------------------|---|
| Information Help line | 1-800-786-9199 |
| Internet PTO-Home Page | http://www.uspto.gov/ |



Anthony D. Stashick
Primary Examiner
Art Unit 3728

ADS
April 28, 2003